

REMARKS

This amendment is submitted in response to the Examiner's Final Action dated May 3, 2005 and pursuant to several unofficial telephone conferences with Examiner discussing entry of the present amendments and possible removal of the finality of the present Office Action. Applicants have amended the claims herein, using as a guide Examiner's comments within the Office Action and the telephonic conferences. No new matter has been added and the amendments place the claims in better condition for appeal. The comments and/or arguments below reference the claims in their amended form.

CLAIM REJECTIONS UNDER 35 U.S.C. § 101

At paragraph 4 of the present Office Action, Claims 11, 12 and 14-17 are rejected under 35 U.S.C. §101. Applicants have amended these claims by massaging the recited elements to more clearly provide subject matter, which Examiner has indicated meets the statutory requirements, without changing the focus or content of the claims. The amendment overcomes the 101 rejection, and Applicants respectfully request removal of the 101 rejections.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

At paragraph 6 of the present Office Action, Claims 1, 2, 4-7, 11, 12, and 14-17 are rejected under 35 U.S.C. §112, first paragraph. Further, at paragraph 8 of the present Office Action, Claims 11, 12, and 14-17 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants have amended these claims to more closely recite features disclosed within the originally filed specification and more recite all features in more definite form. The amendments overcome the 112 rejections, and Applicants again respectfully request removal of the 112 rejections.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

At paragraph 10 of the Office Action, Claims 1, 2, 4-7, 11-12 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over either *Fox* (U.S. Patent No. 5,790,677); *Dorak, Jr.* (U.S. Patent No. 6,389,403) or *Shub* (U.S. Patent No. 6,807,530). None of these three references individually (or in combination with each other) suggests the features of

Applicants' claimed invention, and thus, Applicants' claims are not unpatentable over any of the above references, and should be allowed.

Examiner does not specifically analyze the elements of Applicants' claims against any of the references. Rather, Examiner provides very general arguments about the general content of each reference followed by a generalization that a transaction utility is would have been obvious to one skilled in the art. Clearly, these analyses, which do not address the specific functions provided by the transaction utility, are insufficient to support any conclusion made by Examiner about the non-allowability of Applicants' claims. Applicants point out that providing a first software product or system that enables an E-commerce transaction does not, of itself, render obvious another (second) software product or system that enables E-commerce transaction using different security and confidentiality features to conduct the E-commerce transaction in a manner that provides a different process and result from the first product/system.

Within Applicants' claims, the transaction utility and functionality associated therewith are the core of the invention. Claim 11 recites several of these functions, namely:

a transaction utility for completing said E-commerce transactions utilizing said electronic depository in response to said first party providing said transaction identifier to a second party to said E-commerce transaction, wherein said second party receives only a portion of said personal information of said first party required to complete the transaction; wherein, when said transactions requires a transfer of an item from the second party to the first party, said transaction utility further includes program code that when executed by the processor completes the functions of:

assigning a security routing identifier (SRID) for utilization by said second party to identify a shipment of said item by a shipping service affiliated with said electronic depository, wherein the shipping service is independent of said second party and is utilized to complete said transfer of said item to an address of said first party, and wherein said SRID is initially provided to the second party, who forwards the item along with said SRID and said TID;

receiving said transaction identifier along with said security routing identifier at said depository; and

forwarding at least an address portion of said profile associated with said TID to said shipping service along with said SRID, wherein said shipping service receives the item from said second party tagged with only said SRID and said TID for identification purposes and subsequently sends said item to said first party utilizing at least said address portion of the profile.

None of the references provide a transaction utility that generates both a SRID and a TID that are utilized in the manner described by the above claims elements. *Fox* generally teaches about a credential verification and encryption process within an E-commerce system. Specifically, *Fox* provides:

Unique credentials are produced by the credential binding server based upon the registration packets sent back to the computing units. During the transaction phase, an originating computing unit initially requests, receives, and verifies the credentials of expected recipient computing units to ensure communication between authenticate participants. Thereafter, the originating computing unit signs and encrypts the commerce document(s) and the commerce instrument(s) in a manner which ensures that only the intended recipients can decrypt them. (Abstract).

Figures 1-23 support the above description only. *Fox*, however, does not teach or suggest a SRID (separate from the TID/unique credential) utilized by the merchant to identify a shipment of the item of commerce by a shipping service affiliated with the electronic depository – which ultimately enables shipping of the E-commerce product without releasing the identity of the buyer to the merchant.

As stated in the Abstract, *Dorak* provides:

tracking usage of digital content on user devices... sites for distributing digital content over a computer readable medium to users ... associate unique content identifier with the content associated. Electronic stores coupled to a network sell licenses to play digital content data to users. The licenses contain a unique transaction identifier for uniquely identifying the transaction, and the licenses contain a unique item identifier for uniquely identifying at least one item in the transaction. The content players produce a purchase identifier based upon the mathematical combination of the content identifier, the transaction identifier and the item identifier.

Clearly, *Dorak* teaches about a very different process involving tracking a transaction by providing unique licenses and NOT about enabling confidentiality of the users of the transaction. Applicants are unclear what motivation Examiner found to support use of *Dorak* as a 103 reference other than liberally extrapolating Applicants' recitation two different IDs (TID and SRID) into a different (and very specific) type/genre of online commerce even though the IDs are clearly different and utilized for different functionality.

Shub utilizes encryption to provide confidentiality during an online commerce transaction that may include a shipper associated with the merchant. While *Shub* does provide an “order number,” that order number is not synonymous with nor suggestive of the SRID and one skilled in the art would not conclude that the order number renders Applicants’ SRID obvious.

It should be noted that the above analysis is not meant to be comprehensive, as the references fail to provide other key features which may not be individually addressed herein. For the above reasons, however, one skilled in the art would not find Applicants’ invention obvious in light of the references. Applicants claims are therefore allowable over the references.

CONCLUSION

Applicants have diligently responded to the Office Action by amending the claims to overcome the §101 and §112 rejections and explaining why the claims are not obvious over the references. The amendments and arguments overcome the various rejections, and Applicants, therefore, respectfully request reconsideration of each rejection and issuance of a Notice of Allowance for all claims now pending.

Applicants respectfully request the Examiner contact the undersigned attorney of record at (512) 343-6116 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,



Eustace P. Isidore

Reg. No. 56,104

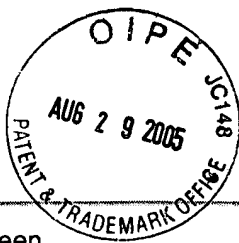
DILLON & YUDELL L.L.P.

8911 N. Capital of Texas Highway
Suite 2110

Austin, Texas 78759

(512) 343-6116

ATTORNEY FOR APPLICANT(S)

**Shenise Ramdeen**

From: Shenise Ramdeen
Sent: Monday, August 01, 2005 2:22 PM
To: 'bmichael@us.ibm.com'
Subject: AUS92000060US2
Attachments: IMAGE (35).PDF

838-8957

Mr. Brown,

We have received an Office Action in the above referenced patent application, a copy of which is attached hereto. Please review the attached Office Action, and the cited reference (U.S. Patent No. 6,807,530 - "Shub") and provide us with the differences between your invention and the cited reference. Preferably, please provide us with your comments by no later than Wednesday, August 3.

If you have any questions, please feel free to contact me.

Best Regards,
Shenise

Shenise D. Ramdeen
Patent Legal Assistant

Dillon & Yudell LLP
8911 N. Capital of Texas Hwy.
Suite 2110
Austin, Texas 78759
512.617.5517 (V)
512.343.6446 (F)
Ramdeen@DillonYudell.com

CONFIDENTIALITY STATEMENT

This communication is for use by the intended recipient(s) only and may contain information that is privileged, confidential and exempt from disclosure or unauthorized use under applicable law. If you are not an intended recipient of this communication, you are hereby notified that any printing, copying, disclosure, distribution or use of this document or information contained herein is strictly prohibited and may be unlawful. This communication is covered by the Electronic Communications Privacy Act, 18 U.S.C. 2510-2521. If you have received this communication in error, you must permanently delete this communication, any attachments and any copies thereof (in any form) from your systems, and destroy any hardcopies you may have printed. Also, please notify the sender by replying to this transmission, or by calling Dillon & Yudell LLP at (512) 343-6116. Unless expressly stated in this email, nothing in this message should be construed as an electronic signature. Thank you for your cooperation.

8/5/2005